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MOSHE, INC. erroneously sued as
8 SCENT-SATION LA;
PERFUME EMPORIUM, INC.,
9 erroneously sued as P.E., INC.

10 UNITED STATES DISTRICT COURT
11 CENTRAL DISTRICT OF CALIFORNIA
12 SOUTHERN DIVISION – SANTA ANA
13

14 SILLAGE, LLC, a California Limited
15 Liability Company,

16 Plaintiff,

17 v.

18 HISTOIRES DE PARFUMS LLC dba
ALICE & PETER, a Delaware Limited
19 Liability Company; SCENT-SATION
LA, a California Limited Liability
20 Company; and P.E., INC., dba
PERFUME EMPORIUM, a California
21 Corporation,

22 Defendants.
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CASE NO. SACV14-00172 CAS RNB

**MEMORANDUM OF POINTS
AND AUTHORITIES OF
DEFENDANTS MOSHE, INC.
AND PERFUME EMPORIUM,
INC. IN OPPOSITION TO
MOTION FOR PRELIMINARY
INJUNCTION**

Date: March 17, 2014

Time: 10:00 a.m.

Courtroom 5

Honorable Christina A. Snyder

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I. INTRODUCTION

In this motion, PLAINTIFF SILLAGE, LLC, (hereinafter “PLAINTIFF” or “SILLAGE”) seeks to enjoin Defendants SCENT-SATION LA; and P.E., INC., dba PERFUME EMPORIUM (collectively “DEFENDANTS”) from manufacturing, using, selling, or offering to sell any infringing product or any product that incorporates or otherwise features the design claimed in its purported design patent, U.S. Patent No. D693,224 (the “D’224 patent”) for the pendency of this litigation.

As described in greater detail below, the conduct sought to be enjoined is ill-defined, overly broad, and otherwise confusing. There are serious questions about whether PLAINTIFF could prevail on the merits, much less whether PLAINTIFF should obtain an injunction. Moreover, an ill-defined injunction is highly prejudicial to DEFENDANTS and will be harmful to DEFENDANTS.

PLAINTIFF’S primary tactic which emerges from its motion is to avoid the weakness of its claim for patent infringement and focus the Court’s attention on its claimed fame and success. However, commercial success cannot buy PLAINTIFF a patent. PLAINTIFF would have to demonstrate that the D’224 patent is actually valid, enforceable, and infringed.

PLAINTIFF will fail, however, because the D’224 patent is invalid and unenforceable. Design patents are not granted to every article that possesses artistic or merchandising acclaim, but only those that are truly inventive. The reintroduction of an old product, even for a new purpose is insufficient to merit the protection of a patent. Also, the obvious combination of design elements already in existence does not entitle one to a patent. Rather, the design patent statutes were created to promote true innovation in industrial design. To fulfill this innovative purpose, a design patent should issue only where there is an invention of a new, original, and ornamental design. PLAINTIFF claims in the D’224 Patent that it has invented the “cupcake style bottle”.

1 PLAINTIFF has not invented anything. Not the cupcake, the cupcake shape,
 2 or even the elements of the cupcake design. In reality, ribbed or fluted containers
 3 (whether made of glass or other material) have existed for centuries. These
 4 containers have a wide variety of shapes, including the concave arcs claimed in the
 5 D'224 Patent. PLAINTIFF may have combined design elements into a single
 6 design which allegedly possess artistic or merchandising advantages, but this falls
 7 short of the true innovation leading to patentability. Calling the design a "cupcake"
 8 does not transform a combination of exiting design elements into a new, original,
 9 and innovative creation. PLAINTIFF's asserted patent is invalid because it is a
 10 simple combination of elements already existing in the exact same industry.

11 Therefore, DEFENDANTS respectfully request that this Court denies this
 12 motion for preliminary injunction.

13 **II. BACKGROUND**

14 PLAINTIFF SILLAGE LLC asserts that it is an entity focused on creating
 15 "perfume jewelry" which could be marketed as a "high-end luxury perfume".
 16 (PLAINTIFF's Memorandum of Points and Authorities ("Motion") p. 4:12-27.)
 17 Nicole Mather ("Mather") purportedly founded PLAINTIFF on April 28, 2010.
 18 Mather claims to have personally designed PLAINTIFF's "cupcake-inspired
 19 perfume bottles and caps."

20 Mather purportedly filed two design patent applications related to the
 21 "cupcake-inspired perfume bottles." The first application was purportedly filed on
 22 April 20, 2011, and was issued on May 1, 2012, as United States Patent
 23 No. D658,503 (the "D'503 Patent"). (See Mather Decl. ¶7, Exhs. A-B.) The
 24 second application was purportedly filed on May 20, 2011, and was issued on
 25 November 13, 2013, as United States Patent No. D693,224 (the "D'224 Patent").
 26 (See Mather Decl. ¶7, Exh. C-D.)

27 PLAINTIFF purportedly introduced its first perfume on November 3, 2011,
 28 and has since released a total of 14 separate bottles.

1 PLAINTIFF filed its Complaint on February 5, 2014. PLAINTIFF
 2 previously filed a Complaint on December 23, 2013, in the Central District of
 3 California, Case No. CV13-01994 CAS RNB against the same defendants and
 4 asserting the same four causes of action. PLAINTIFF alleges that DEFENDANTS
 5 have (1) infringed the D'224 Patent and the D'503 Patent, (2) infringed
 6 PLAINTIFF's trade dress, (3) infringed PLAINTIFF's registered trademark,
 7 CHERRY GARDEN, and (4) violated Business and Professions Code §§17200, *et*
 8 *seq.*

9 Defendant Moshe, Inc., is a California corporation doing business as Scent-
 10 Sation (hereinafter referred to as "Scent-Sation") and erroneously sued as SCENT-
 11 SATION LA. (Declaration of Mosha Yhudai ("Yhudai Decl.") ¶1.) Scent-Sation
 12 is, and always has been, a wholesaler and retailer of various perfumes and
 13 fragrances. (*Id.* at ¶ 5.) Scent-Sation has its own line of perfumes and fragrances,
 14 known as "Eclectic Collections". (*Id.* at ¶ 6.)

15 At any given time, Scent-Sation carries 500+ different perfumes. (*Id.* at ¶ 8.)
 16 In or around April 2013, Scent-Sation purchased perfume (the "Alice & Peter
 17 Perfume") purportedly created by Defendant HISTORIES DE PARFUMS LLC
 18 d/b/a ALICE & PETER ("Alice & Peter"). Scent-Sation purchased the Alice &
 19 Peter Perfume from a third-party vendor. (*Id.* at ¶ 9.)

20 Scent-Sation does not design, manufacture, import, or otherwise participate
 21 in the creation of any Alice & Peter perfume. (*Id.* at ¶ 10.) Scent-Sation only
 22 purchased and resold the Alice & Peter perfume which was obtained from a third-
 23 party vendor. (*Id.*)

24 Scent-Sation has sold some of the Alice & Peter perfume at wholesale.
 25 Scent-Sation sold the Alice & Peter perfume at wholesale at a price between \$12.00
 26 and \$19.00 per bottle. (*Id.* at ¶ 11.) Scent-Sation has also sold some of the Alice &
 27 Peter perfume at retail. (*Id.*) Scent-Sation sold some of the Alice & Peter perfume
 28 at retail for less than \$30.00 per bottle. (*Id.*)

1 Defendant Perfume Emporium, Inc., is a Nevada Corporation (hereinafter
 2 referred to as “Perfume Emporium”), and erroneously sued as P.E., INC.
 3 (hereinafter Scent-Sation and Perfume Emporium are referred to collectively as
 4 “DEFENDANTS”). Perfume Emporium was incorporated on or around May 26,
 5 2000. Perfume Emporium is an on-line retailer of perfumes and fragrances.
 6 Perfume Emporium offers its products through its website which can be found at
 7 <http://perfumeemporium.com>.

8 Perfume Emporium obtains all of its goods from distributors, not directly
 9 from manufacturers. At any given time, Perfume Emporium offers hundreds to
 10 thousands of different perfumes on its web site.

11 Perfume Emporium sold perfume purportedly manufactured by Defendant
 12 HISTORIES DE PARFUMS LLC d/b/a ALICE & PETER (“Alice & Peter
 13 Perfume”). The Alice & Peter Perfume was sold for \$33.99 per item.

14 Perfume Emporium does not design, manufacture, import, or otherwise
 15 participate in the creation of the Alice & Peter Perfume. Perfume Emporium only
 16 purchased the Alice & Peter Perfume and resold them at retail.

17 Prior to the initiation of this action, DEFENDANTS were not familiar with
 18 Plaintiff or any of its purported products. (Yhudai Decl. at ¶ 13.) DEFENDANTS
 19 have never had a customer request for any perfume manufactured, distributed, or
 20 otherwise generated by PLAINTIFF. (*Id.* at ¶ 14.) DEFENDANTS have never
 21 observed a single instance of consumer confusion between Alice & Peter’s
 22 purported products and Plaintiff’s purported products. (*Id.* at ¶ 15.).

23 **III. ANALYSIS**

24 **A. PLAINTIFF Fails to Show It Is Entitled to the Extraordinary and** 25 **Drastic Remedy of a Preliminary Injunction.**

26 The Supreme Court has stated that “a preliminary injunction is an
 27 **extraordinary and drastic remedy** and should not be granted unless the movant,
 28 by a clear showing, carries the burden of persuasion.” (*Mazurek v. Armstrong*,

1 520 U.S. 968, 972 (1997) (emphasis added).) This wise counsel has been echoed
 2 by the Federal Circuit: “A preliminary injunction is a ‘drastic and extraordinary
 3 remedy that is not to be routinely granted.’” (Nat’l Steel Car, Ltd. v. Canadian Pac.
 4 Ry., Ltd., 357 F.3d 1319, 1324-1325 (Fed. Cir. 2004) (quoting Intel Corp. v. ULSI
 5 Sys. Tech., Inc., 995 F.2d 1566, 1568 (Fed. Cir. 1993)).)

6 To obtain a preliminary injunction, Plaintiff must demonstrate: (1) that it is
 7 **likely to succeed** on the merits, (2) that it is **likely to suffer irreparable harm** in
 8 the absence of preliminary relief, (3) that the balance of equities tips in its favor,
 9 and (4) that an injunction is in the public interest. (Winter v. NRDC, Inc., 555 U.S.
 10 7, 21-22 (2008) (emphasis added); Nat’l Steel Car, supra, 357 F.3d at 1324-1325
 11 (citing Jack Guttman, Inc. v. Kopykake Enters., Inc., 302 F.3d 1352, 1356 (Fed.
 12 Cir. 2002); Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1350
 13 (Fed. Cir. 2001). If any one element is lacking, the court should not issue a
 14 preliminary injunction. (See Nat’l Steel Car, supra, 357 F.3d at 1324-1325.)

15 Additionally, the focus on this analysis is limited to Plaintiff’s claim of
 16 infringement of the D’224 Patent because it limited its motion to this claim. (See
 17 Plaintiff’s Notice of Motion for Preliminary Injunction, p.1:2-13.)

18 1. There Is No Likelihood of Success On the Merits Because the D’224
 19 Patent Is Plainly Invalid.

20 Plaintiff is first required to establish is that it is likely to succeed on the
 21 merits at trial. The Federal Circuit identified a likelihood of success as a critical
 22 element which cannot be overlooked in light of even substantial evidence related to
 23 the other three factors. (See Nat’l Steel Car, supra, 357 F.3d at 1324-1325 (“[A]
 24 district court cannot use an exceptionally weighty showing on one of the other three
 25 factors to grant a preliminary injunction if a movant fails to demonstrate a
 26 likelihood of success on the merits.”).) Thus, PLAINTIFF’s failure to prove a
 27 likelihood of success ends the analysis because no preliminary injunction may be
 28 issued in such an absence.

1 “With regard to the first factor--establishing a likelihood of success on the
 2 merits--the patentee [Plaintiff] seeking a preliminary injunction in a patent
 3 infringement suit must show that it will likely prove infringement, **and that it will**
 4 **likely withstand challenges, if any, to the validity of the patent.**” (*Titan Tire v.*
 5 *Case New Holland*, 566 F.3d 1372, 1376-77 (Fed. Cir. 2009) (emphasis added).)

6 When the validity of a patent is challenged, “instead of the alleged infringer
 7 having to persuade the trial court that the patent is invalid, at this stage it is the
 8 **patentee**, the movant, **who must persuade the court that**, despite the challenge
 9 presented to validity, **the patentee nevertheless is likely to succeed at trial on the**
 10 **validity issue.** (*Id.* (emphasis added).)

11 Plaintiff asserts that DEFENDANTS hold “the burden of proving invalidity”.
 12 (Motion p. 17:10-13 (citing *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1339
 13 (Fed. Cir. 2003).) This is misleading. “In resisting a preliminary injunction,
 14 however, one need not make out a case of actual invalidity. Vulnerability is the
 15 issue at the preliminary injunction stage, while validity is the issue at trial.”
 16 (*Amazon.com, supra*, 239 F.3d at 135.)

17 Given the extraordinary nature of a preliminary injunction, the Federal
 18 Circuit has set a high threshold for Plaintiff to establish a likelihood of success.
 19 Specifically, a patentee is expected to “‘clearly [show]’ that his patent is valid and
 20 infringed” before a court may preliminarily enjoin the alleged infringer. (*Atlas*
 21 *Powder Co. v. Ireco Chems.*, 773 F.2d 1230, 1233 (Fed. Cir. 1985).) “A patent
 22 holder seeking a preliminary injunction bears the ultimate burden of establishing a
 23 likelihood of success on the merits with respect to the patent's validity.” (*Altana*
 24 *Pharma AG v. Teva Pharms. USA, Inc.*, 566 F.3d 999, 1005 (Fed. Cir. 2009) (citing
 25 *Entegris, Inc. v. Pall Corp.*, 490 F.3d 1340, 1351 (Fed. Cir. 2007).

26 In light of the patentee’s burden to clearly show that the patent is valid and
 27 infringed, once the alleged infringer raises a “substantial question” of invalidity, the
 28 preliminary injunction should not issue. (*Id.*; *Genentech, Inc. v. Novo Nordisk A/S*,

1 108 F.3d 1361, 1364 (Fed. Cir. 1997). “The burden on the accused infringer to
 2 show a substantial question of invalidity at this stage is lower than what is required
 3 to prove invalidity at trial.” (Altana Pharma AG v. Teva Pharms. USA, Inc.,
 4 566 F.3d 999, 1006 (Fed. Cir. 2009))

5 PLAINTIFF’s motion is based solely on the alleged infringement of the
 6 D’224 patent. However, PLAINTIFF has failed to meet its burden of establishing
 7 the validity of its patent, relying instead on the presumption of validity. The D’224
 8 Patent is actually overwhelmingly vulnerable to invalidity because of procedural
 9 and substantive flaws which should have resulted in a complete refusal to issue the
 10 patent by the USPTO.

- 11 a. Plaintiff has presented no evidence to support the validity of its
 12 patent, but rather it relies on the presumption alone.

13 PLAINTIFF’s motion exhausts a total of three lines presenting conclusory
 14 statements somewhat related to validity. (See Motion, pp. 17:25-18:2.) Rather than
 15 make any attempt to fortify its position on validity, it appears PLAINTIFF elected
 16 to hope that DEFENDANTS would not challenge the validity of the D’224 Patent
 17 and that the presumption alone would suffice. PLAINTIFF will have no such luck
 18 and cannot rely solely on the presumption of validity. (See Motion p.17:15-19
 19 (quoting Canon Computer Sys. v. Nu-Kote Int’l, 134 F.3d 1085, 1088 (Fed. Cir.
 20 1998)).)

- 21 b. The D-224 Patent was improperly granted as it was subject to
 22 an obviousness-type double patenting rejection due to the
 23 D’503 Patent which was applied for and granted before the
 more generic D’224 Patent.

24 Design patents are subject to the “double patenting” doctrine which precludes
 25 a patentee from obtaining two separate design patents covering the same design.
 26 The doctrine is derived from 35 U.S.C. § 171 which states: “Whoever invents any
 27 new, original, and ornamental design for an article of manufacture may obtain a
 28 patent therefor, subject to the conditions and requirements of this title.”

1 “To prevent extension of the patent right beyond statutory limits, the doctrine
 2 of obviousness-type double patenting rejects application claims to subject matter
 3 different but not patentably distinct from the subject matter claimed in a prior
 4 patent.” (In re Goodman, 11 F.3d 1046, 1052-1053 (Fed. Cir. 1993) (citing In re
 5 Braat, 937 F.2d 589, 592 (Fed. Cir. 1991). Obviousness-type double patenting is a
 6 question of law. (Texas Instruments Inc. v International Trade Commission,
 7 988 F.2d 1165, 1179 (Fed. Cir. 1993).

8 The double patenting determination involves two separate inquiries. The
 9 first inquiry centers on the claims of the patent and asks whether the same invention
 10 is claimed twice. (General Foods Corp. v. Studiengesellschaft Kohle mb H,
 11 972 F.2d 1272, 1278 (Fed. Cir. 1992). If the claimed inventions have the same
 12 scope, the proper rejection is under 35 U.S.C. § 171 because an inventor is entitled
 13 to a single patent for a design. (Miller v. Eagle Mfg. Co., 151 U.S. 186, 197
 14 (1894).)

15 If one claimed invention has a broader scope than the other, the court must
 16 proceed to a second inquiry: whether one claim defines merely an obvious variation
 17 of the other patent claim. (In re Vogel, 422 F.2d 438, 441 (C.C.P.A. 1970).)

18 There can be no colorable argument that the D’503 Patent and the D’224
 19 Patent embody different designs. A simple look and comparison of the design
 20 claimed in the D’224 Patent and the design claimed in the design claimed in the
 21 D’503 patent show that both patents claim the same design:

22 ///

23 ///

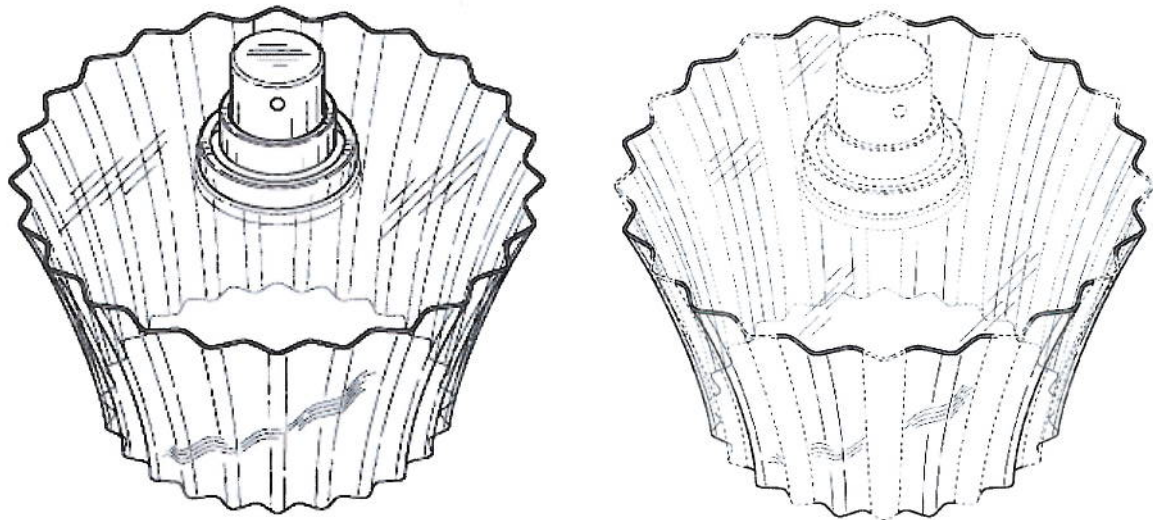
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D'503 Patent

D'224 Patent

Figure 1 – The D'503 Patent and the D'224 Patent

Both involve the same arc-shaped ridges in a circular orientation. Both display what appears to be an identical spray nozzle in the middle of the top section of the design. Both display exactly 24 ridges along the side of the design. Both a bottom section that is proportionately smaller than the top. There are simply no differences (with the exception of the orientation of the shading lines) of any kind.

The D'503 Patent was filed with the USPTO and issued by the USPTO before the D'224 Patent. Every single element claimed in the D'224 Patent was previously disclosed and claimed in the D'503 Patent application. Given the dramatic overlap of the claimed design, it is clear that the D'224 Patent functions to merely extend the term of the design patent protection. A design patent is valid for 14 years after the issuance of the patent. (35 U.S.C § 289.) The D'503 Patent was issued on May 1, 2012, and its corresponding term of protection would extend to May 1, 2026. The D'224 Patent, however, was issued on November 12, 2013, and its term of protection would extend to November 12, 2027.

Thus, by filing a second patent application (the D'224 Patent) which is not patentably distinct for the first application, and whose elements were completely disclosed and claimed in the first application (the D'503 Patent), PLAINTIFF has

1 improperly obtained an extended term for the design originally disclosed and
 2 claimed in the D'503 Patent. The D'224 should have been rejected on that ground
 3 during the prosecution, and it remains invalid as issued.

4 Here, PLAINTIFF has no likelihood of success on the merits of its action
 5 because the only patent on which it has moved, the D'224 Patent was invalidly
 6 granted and remains invalid and unenforceable.

7 c. PLAINTIFF did not “invent” the “cupcake” or ribbed perfume
 8 container, but rather combined basic elements from prior art.

9 In addition to the invalidity created by PLAINTIFF's double patenting,
 10 PLAINTIFF's D'224 Patent is invalid because it was not a new and original design
 11 at the time the application was filed. A basic requirement of all patents, whether
 12 they be design or utility patents, is that the claimed invention or design must be
 13 original, or non-obvious. (35 U.S.C. §§ 103, 171.) Specifically, 35 U.S.C. § 103
 14 provides: “A patent for a claimed invention may not be obtained, notwithstanding
 15 that the claimed invention is not identically disclosed as set forth in [35 U.S.C.
 16 § 102], if the differences between the claimed invention and the prior art are such
 17 that the claimed invention as a whole would have been obvious before the effective
 18 filing date of the claimed invention to a person having ordinary skill in the art to
 19 which the claimed invention pertains.” These requirements also apply to design
 20 patent claims. (See 35 U.S.C. § 171; *In re Haruna*, 249 F.3d 1327, 1335 (Fed Cir.
 21 2001).)

22 In particular, the requirement of non-obviousness ensures that the claimed
 23 design reflects the “exercise of the inventive or originaive faculty” as is required
 24 for all patents. (*Smith v. Whitman Saddle Co.*, 148 U.S. 674, 679 (1893).) “**The**
 25 **exercise of the inventive or originaive faculty is required, and a person cannot**
 26 **be permitted to select an existing form and simply put it to a new use any more**
 27 **than he can be permitted to take a patent for the mere double use of a**
 28 **machine.**” (*Id.* (emphasis added).) Expressed in other terms, the requirement of

1 non-obviousness excludes those claimed designs which may possess artistic or
 2 merchandising success but fall short of a creative invention. (Patriarca Mfg., Inc. v.
 3 Sosnick, 278 F.2d 389, 391-392 (9th Cir. 1960).)

4 As eloquently stated by the Ninth Circuit, “[o]ne may well agree that the
 5 patented [design] presents a more pleasing appearance and one more calculated to
 6 tempt the customer. One may well conclude that, **artistically and from a**
 7 **merchandising point of view, the patented [design] marks an advance in**
 8 **matters of design. Not every advance, however, is the result of creative**
 9 **invention. More often it can be credited to the normal progress which results**
 10 **when discriminating taste and judgment are applied to that which has already**
 11 **been discovered or created.” (Id. (emphasis added).)**

12 In addressing a claim of obviousness in a design patent, “the ultimate
 13 inquiry . . . is whether the claimed design would have been obvious to a designer of
 14 ordinary skill who designs articles of the type involved.” (Apple, Inc. v. Samsung
 15 Elecs. Co., 678 F.3d 1314, 1329-1330 (Fed. Cir. 2012) (citing Titan Tire, 566 F.3d
 16 at 1375; Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed. Cir. 1996)).¹

17 The test set forth in Durling (as applied in Apple v. Samsung, 678 F.3d at
 18 1329-1330) provides a clear and concise framework for assessing the obviousness
 19 of a claimed design. In Durling, the court explained that a design patent may be
 20 invalid as obvious if it “would have been obvious to a designer of ordinary skill
 21 who designs articles of the type involved ... [to] combine[] teachings of [multiple]
 22 prior art [references] to create the same overall visual appearance as the claimed
 23 design.” (Durling, *supra*, 101 F.3d at 103.) In the case at hand, the D’224 Patent
 24 must be analyzed as to a designer of ordinary skill who designs perfume, fragrance,
 25

26 ¹ See also Payne Metal Enterprises, Ltd. v. McPhee, 382 F.2d 541 (9th Cir. 1967) (Court determining patentability of
 27 design must decide whether changes over prior art resulted in appearance of design as whole which would not have
 28 been obvious to person of ordinary skill in art.); In re Garbo, 287 F.2d 192 (C.C.P.A. 1961) (Patentable design may
 contain old elements but, in order to be patentable, finished product must have unobvious appearance and not be
 merely result of obvious combination of old elements).)

1 or similar containers.

2 This requires that “one must find a single reference, ‘a something in
3 existence, the design characteristics of which are basically the same as the claimed
4 design.’” (*Id.* (quoting *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982))). Once
5 this reference is found, other references “may be used to modify it to create a
6 design that has the same overall visual appearance as the claimed design.” (*Id.*)
7 Further, these additional references must be sufficiently related that “the
8 appearance of certain ornamental features in one would suggest the application of
9 those features to the other.” (*Id.* (quoting *In re Borden*, 90 F.3d 1570, 1575
10 (Fed. Cir. 1996))).

11 While expert testimony may be “most helpful” in determining whether or not
12 a claimed design is obvious, the Court is not precluded from making that
13 determination in the absence of such testimony. (*Petersen Mfg. Co. v. Central*
14 *Purchasing, Inc.*, 740 F.2d 1541, 1547-1548 (Fed. Cir. 1984).) At this stage, where
15 all that is at issue is the vulnerability of the D’224 Patent to a finding of invalidity,
16 the Court can certainly make the determination on the vulnerability of the D’224
17 Patent to an attack on its obviousness.

18 While the small window of time provided by Plaintiff’s Motion for
19 Preliminary Injunction has precluded a full search and examination of all the
20 perfume bottles created throughout the centuries, it is certainly clear that Plaintiff’s
21 conical frustum with ribbed or fluted edges (which it calls a cupcake), is neither a
22 new or non-obvious creation. As an initial matter, it is clearly beyond dispute that
23 Plaintiff did not invent the cupcake, or the shape of a cupcake or the “slight[ly]
24 concave curve from the top to the bottom” which is generally found in cupcakes.
25 The fact that PLAINTIFF refers to its own design as a cupcake actually undermines
26 its assertion that there was any inventive creation associated with the design
27 claimed in the D’224 Patent because of the cupcake’s well-known, familiar shape.

28 PLAINTIFF would have the Court believe that there is no prior art which

1 could possibly undermine the validity of the D'224 Patent. (See Motion pp. 17:25-
 2 18:2, fn.1.) However, the six (6) design patents cited as prior art by the examiner
 3 can hardly be considered the full scope of prior art upon which the D'224 Patent
 4 and its application read. The full scope of the prior art is set by 35 U.S.C. 102(a)
 5 and includes anything that was "patented, described in a printed publication, or in
 6 public use, on sale, or otherwise available to the public before the effective filing
 7 date of the claimed invention." This would include the countless perfumes,
 8 colognes, bottles, and other related items in a seemingly endless number of catalogs
 9 and other publications, advertisements, and descriptions.

10 DEFENDANTS' swift review of some of the more readily available sources²
 11 has produced numerous "things in existence" which have the same or similar
 12 characteristics as Plaintiff's claimed invention. (See Yhudai Decl. ¶12, Exh. A;
 13 Isaacson Decl. Exhs. B, C.) Some of these "things in existence" are shown below
 14 in comparison to PLAINTIFF's. Looking at these examples which have arisen
 15 from barely scratching the surface of the prior art available, it is clear that
 16 Plaintiff's claimed design is either (1) completely anticipated by a single prior art
 17 reference, or (2) an obvious combination/modification of elements from things in
 18 existence.

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26 _____
 27 ² For purposes of this Opposition, DEFENDANTS have focused their research and analysis on perfume/fragrance
 28 bottles which were clearly in existence prior to Plaintiff's alleged invention of the cupcake. However, going forward,
 there are certainly other categories of "things in existence" including, but not limited to, blown glass articles, bowls,
 candy dishes, and other toiletry containers which will constitute prior art and obviate PLAINTIFF's "invention".



Figure 2 - The D'224 Patent Drawing and Related Prior Art

PLAINTIFF's D'224 Patent "claims the curved and ridged edge sections shown in the D'224 Patent figures". (Motion p. 15:23-24.) The D'224 Patent does not extend to the spray mechanism or the separate top pieces of Plaintiff's products. (Motion pp. 6:5-7:4.) DEFENDANTS have already identified multiple examples of things in existence which include the same or similar "curved and ridged edge sections" claimed by PLAINTIFF. (See Yhudai Decl. ¶12, Exh. A; Isaacson Decl. Exhs. B, C.) Any subtle differences between these articles and the claimed design in the D'224 Patent are certainly not patentably distinct sufficient to allow PLAINTIFF to assert that the D'224 Patent is a "new, original, and ornamental design." Thus, the D'224 Patent is invalid because it is a simple and obvious combination of elements from the prior art.

DEFENDANTS' burden, at this stage, is not to prove invalidity, but to raise a

1 substantial question which demonstrates the vulnerability of the D'224 Patent.
 2 DEFENDANTS have done this and more. The things in evidence found from
 3 quick, simple research call into question the obviousness of the D'224 Patent so
 4 seriously that there is simply no way PLAINTIFF can demonstrate that it is likely
 5 to succeed on the merits. As such, PLAINTIFF cannot be entitled to a preliminary
 6 injunction and its motion should be denied in its entirety.

7 d. PLAINTIFF's claims of "secondary indicia" of non-
 8 obviousness are conclusory red herrings because there is no
 9 nexus between the purported indicia and the claims of D'244
 Patent.

10 PLAINTIFF's quick comments on the "secondary indicia of non-
 11 obviousness" are unavailing to the invalidity of the D'224 Patent. There are so-
 12 called "secondary inidica of non-obviousness", such as commercial success, which,
 13 if present, indicate that a patent was not obvious when created. (Litton Systems,
 14 Inc. v. Whirlpool Corp., 728 F.2d 1423, 1443 (Fed. Cir. 1984).) However,
 15 PLAINTIFF must demonstrate that the success and notoriety is due to the design
 16 itself. "To be of value, evidence of commercial success must **clearly establish that**
 17 **the commercial success is attributable to the design**, and not to some other
 18 factor, such as a better recognized brand name or improved function." (Id.
 19 (emphasis added).)

20 PLAINTIFF has made no showing that the success it has enjoyed is
 21 attributable to the design claimed in the D'224 Patent alone. Even the articles and
 22 comments regarding PLAINTIFF's product line are not focused solely on the
 23 portion claimed in the D'224 Patent, but rather on the whole product including a
 24 highly decorative top. (PLAINTIFF's Exhs. F-R.) As can be seen in Figure 3
 25 below, the substantial elements added to PLAINTIFF's market presentation of its
 26 products strongly suggests that any acclaim and success is not focused on the
 27 "curved and ridged edge sections shown in the D'224 Patent figures". Rather,
 28 one's attention is clearly drawn to the ornate decorations and embellishments found

1 in PLAINTIFF's market presentation of its products including tigers, crystals, and
 2 snow globes. PLAINTIFF could hardly claim that it would win awards by selling a
 3 simple glass (or plastic for that matter) bottle incorporating the D'224 Patent's
 4 design without anything else added.



Figure 3 – The D'224 Patent and Plaintiff's Products Presented to the Market

14 Additionally, it is unclear whether the purported commercial success has
 15 anything to do at all with PLAINTIFF's product packaging. PLAINTIFF is
 16 referred to as a "luxury haute parfumerie". (PLAINTIFF's Exh. I.) In fact,
 17 PLAINTIFF's founder, Nicole Mather, stated in December 2011 that she created
 18 PLAINTIFF because she wanted "to return to the art of fragrance making using the
 19 best quality ingredients to produce exciting luxury scents that stand apart from the
 20 mass-market perfume houses." (PLAINTIFF's Exh. H.) Given PLAINTIFF's
 21 clear focus on the quality of its fragrances, it is possible that the commercial
 22 success is alleged to be derived not from the design claimed in the D'224 Patent, but its
 23 fragrances.

24 Finally, PLAINTIFF's own motion provides another explanation, unrelated
 25 to the D'224 Patent, for its alleged commercial success. PLAINTIFF states that in
 26 order to promote its product, PLAINTIFF "has expended significant time, energy,
 27 and expense" on tradeshow, interviews, print ads, online marketing, couture
 28 events, advertising, and marketing. (Motion pp.7:27-8:2) If PLAINTIFF's success

1 is derived from its investment of time, energy, and expense, as well as from its
 2 judgment, then it is of no value in determining whether or not the D'224 Patent was
 3 non-obvious .

4 PLAINTIFF's attempts to salvage the validity of the D'224 Patent through
 5 secondary indicia of non-obviousness are futile here. First, PLAINTIFF's patent is
 6 void of any inventive quality in light of the prior art and "[w]here invention is
 7 plainly lacking commercial success cannot fill the void." (Patriarca Mfg., Inc. v.
 8 Sosnick, 278 F.2d 389, 391 (9th Cir. 1960).) Second, even the alleged secondary
 9 indicia of non-obviousness are unavailing because PLAINTIFF has made no
 10 attempt to demonstrate a nexus because the alleged success and the D'224 Patent.

11 Again, PLAINTIFF's motion has failed to demonstrate a likelihood of
 12 success on the merits because the D'224 Patent is invalid as an obvious
 13 combination of elements from the prior art. As such, PLAINTIFF's request for a
 14 preliminary injunction must be denied.

15 **B. There Is No Irreparable Harm**

16 In this case, as demonstrated below, PLAINTIFF has not demonstrated that it
 17 is likely to suffer irreparable harm if this motion is not granted.

18 "Courts have consistently identified a showing of likely irreparable harm as
 19 the single most important prerequisite for the issuance of a preliminary injunction;
 20 Plaintiff must make that showing before the other requirement for the issuance of a
 21 preliminary injunction need even be considered." (Inspection Management
 22 Systems, Inc v. Open Door Inspections, Inc., 2009 U.S. Dist. LEXIS 23524, at *3
 23 (E.D. Cal., Mar. 26, 2009) (citing Dominion Video Satellite, Inc. v. Echostar
 24 Satellite Corp., 356 F.3d 1256, 1260-61 (10th Cir. 2004).)

25 Previously, courts would generally presume the existence of irreparable
 26 injury in trademark infringement cases. (See Brookfield Communs., Inc. v. West
 27 Coast Entertainment Corp., 174 F.3d 1036, 1066 (9th Cir. 1999).) However, in
 28 eBay, Inc. v. MercExchange, L.L.C., 547 U.S. 388, 393 (2006), the Supreme Court

1 rejected any presumption of irreparable harm in the issuance of injunctive relief
2 related to allegations of patent infringement.

3 1. The Lack of Any Likelihood of Success Negates Any Threat of
4 Irreparable Harm.

5 The first reason PLAINTIFF is not likely to suffer irreparable harm is that
6 there is barely a glimmer of wishful thinking that the D'224 Patent is valid and
7 enforceable. Given the likelihood that PLAINTIFF's D'224 Patent is invalid and
8 unenforceable, there is a correspondingly small chance that the absence of a
9 preliminary injunction will result in any harm at all to PLAINTIFF. Rather, a
10 determination on the merits will certainly lead to a finding that PLAINTIFF's
11 D'224 Patent is invalid and PLAINTIFF has not suffered any harm as a result.

12 2. PLAINTIFF Has Engaged In An Unexplained Delay of Over a Year
13 Which Completely Undermines Its Claim Of Irreparable Harm.

14 Preliminary injunctions are drastic and extreme remedies. They are intended
15 only to prevent irreparable harm that will occur during litigation. A preliminary
16 injunction is justified only where there is an exigency that demands an immediate
17 injunction during litigation.

18 PLAINTIFF is not entitled to a preliminary injunction because its
19 **SUBSTANTIAL DELAY in seeking a preliminary injunction** is compelling
20 evidence there is no immediate and irreparable harm. An "undue delay, standing
21 alone, constitutes grounds for rejecting a motion for preliminary injunction."
22 (Protech Diamond Tools, Inc. v. Liao, 2009 U.S. Dist. LEXIS 53382 at *19-20
23 (N.D. Cal. June 5, 2009); Oakland Tribune, Inc. v. Chronicle Pub. Co., 762 F.2d
24 1374, 1378 (9th Cir. 1985) (affirming denial of preliminary injunction based on
25 delay alone, without assessing the likelihood of success on the merits).)
26 Specifically, a "long delay before seeking a preliminary injunction **implies a lack**
27 **of urgency and irreparable harm.**" (Id. at 1377 (emphasis added).) Also,
28 "[w]here no new harm is imminent," a court is "not required to issue a preliminary

1 injunction against a practice which has continued unchallenged for several years.”
 2 (Id. at 1377.) The Federal Circuit has previously affirmed the denial of a
 3 preliminary injunction where a patentee waited for 15 months before bringing its
 4 motion for a preliminary injunction. (T.J. Smith & Nephew, Ltd. v. Consolidated
 5 Medical Equipment, Inc., 821 F.2d 646 (Fed. Cir. 1987).)

6 The case at hand presents a delay of similar proportion to T.J. Smith.
 7 Defendant Alice & Peter purportedly introduced their perfumes into the market in
 8 November 2012. (Motion p. 10:8-12.) Further, PLAINTIFF previously filed a
 9 Complaint alleging the same causes of action in the Central District of California on
 10 December 23, 2013. (Isaacson Decl. ¶ 5, Exh. D.) Despite this, PLAINTIFF did
 11 not seek a preliminary injunction until the middle of February 2014. PLAINTIFF
 12 does not address or attempt to justify the delay.

13 Basically, the question is, if PLAINTIFF could wait for 15 months after the
 14 Alice & Peter Perfume purportedly entered the market to bring a motion for
 15 preliminary injunction, why can it not wait until there is a determination on the
 16 merits of its claims to seek an injunction?

17 3. PLAINTIFF Has Failed to Demonstrate Is Has Suffered Any Actual
 18 Harm.

19 PLAINTIFF has asserted that Defendant Alice & Peter introduced the
 20 allegedly infringing perfume bottles over a year ago. (Motion p. 10:8-12.) Not
 21 only has PLAINTIFF delayed substantially in bringing its motion, but PLAINTIFF
 22 has also failed to identify any specific harm it has already suffered from the
 23 introduction of Alice & Peter’s Perfume.

24 PLAINTIFF claims that there is irreparable harm because DEFENDANTS
 25 are interfering with its exclusive rights granted by the D’224 Patent. (Motion
 26 p. 19:10-12.) This argument is legally unsound. If this “interference” argument
 27 were sufficient to demonstrate irreparable harm, there would be a de facto
 28 presumption of irreparable harm because every instance of alleged patent

1 infringement involves a claim of interference with the exclusive rights of the patent.
 2 PLAINTIFF must do more than argue interference with its purported exclusive
 3 rights to demonstrate it is likely to suffer irreparable harm.

4 PLAINTIFF also argues that irreparable harm will occur at upcoming trade
 5 shows in Italy. (Motion pp. 12:19-27; 19:18-22.) However, it is well known that
 6 United States patent laws “do not, and were not intended to, operate beyond the
 7 limits of the United States.” (Brown v. Duchesne, 60 U.S. 183, 195, 15 L. Ed. 595
 8 (1856); Rotec Indus., Inc. v. Mitsubishi Corp., 215 F.3d 1246, 1251 (Fed. Cir.
 9 2000) (“extraterritorial activities, however, are irrelevant to the case before us,
 10 because the right conferred by a patent under our law is confined to the United
 11 States and its territories, and infringement of this right cannot be predicated on acts
 12 wholly done in a foreign country” (internal citation omitted)). Thus, PLAINTIFF’s
 13 concerns about the trade shows in Italy are irrelevant and must be ignored.

14 PLAINTIFF also laments about the “impulse purchases in niche perfume
 15 retail stores” who may choose the Alice & Peter’s perfume over PLAINTIFF’s.
 16 (Motion p.19:23-27.) However, PLAINTIFF’s website indicates that, in the United
 17 States, PLAINTIFF’s products can only be found in two retail stores. (Isaacson
 18 Decl. ¶ 6, Exh. E.) It is not clear, therefore, who these “impulse purchasers” are
 19 and whether there is really any risk presented. Furthermore, given the price
 20 discrepancy between Plaintiff’s products and Alice & Peter’s perfume —
 21 purportedly up to \$1,451-it is unlikely that even such “impulse purchasers would
 22 view the products as interchangeable substitutes. (Yhudai Decl. ¶ 16.) Thus, any
 23 such sales would not be lost due to the alleged infringement, but the dynamics of
 24 the competitive market.

25 Finally, PLAINTIFF claims that it has had discussions about creating a
 26 completely new line of product that diverges from its current \$300+ product lines
 27 that would be sold to mass market retailers. (Motion p. 20:6-14.) PLAINTIFF
 28 claims that it is suffering irreparable harm by the mere existence of the Alice &

1 Peter's Perfumes in the market. However, PLAINTIFF apparently has done no
 2 more than talk about the possibility while the Alice & Peter's Perfumes have been
 3 purportedly on the market for over a year. If PLAINTIFF believed its opportunity
 4 to participate in the market is being harmed, why has it done nothing more that
 5 have discussions? Furthermore, PLAINTIFF was created "to produce exciting
 6 luxury scents that stand apart from the mass-market perfume houses."
 7 (PLAINTIFF's Exh. H.) This raises doubt whether PLAINTIFF would actually
 8 change its entire purpose and enter into direct competition with the mass-market
 9 perfume houses.

10 In the end, PLAINTIFF has done no more than present its theories of harm as
 11 a result of DEFENDANTS' alleged conduct. However, these theories are baseless,
 12 speculative, and not connected to irreparable harm. Thus, PLAINTIFF has failed to
 13 demonstrate any theory of irreparable harm to justify its request for a preliminary
 14 injunction related to the D'224 Patent.

15 **C. The Public Interest Is Not Served By An Injunction Stemming From An**
 16 **Invalid Patent Which Unnecessarily Constrains Competition.**

17 PLAINTIFF argues that the public interest is served by protecting patents
 18 rights because they support innovation. (Motion p.22:5-18.) However, this can
 19 only be true where there are legitimate patent rights to protect. In the case of an
 20 invalid patent, particularly one that is invalid because it claims an obvious
 21 invention, protecting the patent will not support innovation. (See, e.g., Kalipharma,
 22 Inc. v. Bristol-Myers Co., 707 F.Supp. 741, 756-757 (S.D.N.Y. 1989). ("Of course,
 23 public policy favors enforcement of valid patent rights, including the right to
 24 exclude others. [] The key word here is 'valid', however, and in this case plaintiff
 25 has strongly and convincingly challenged the patent's validity. . . . The converse is
 26 also true, that a court should be cautious to use its equity powers when a challenger
 27 has so clearly challenged the patent's validity.").)

1 **D. PLAINTIFF's Request Injunction Is Ill-Defined Which Will Cause**
 2 **Undue Hardship and Incalculable Harm to DEFENDANTS Due to Its**
 3 **Undefined Limitations.**

4 Should the Court find that despite the overwhelming evidence raising at least
 5 a substantial question as to validity a preliminary injunction is warranted,
 6 PLAINTIFF's proposed preliminary injunction is unacceptable.

7 In its proposed preliminary injunction, PLAINTIFF seeks an injunction
 8 against DEFENDANTS from "directly or indirectly . . . making, using, offering to
 9 sell, or selling within the United States or importing into the United States any
 10 bottle which infringes the design claimed in U.S. Patent No. D'693,224."
 11 (PLAINTIFF's Proposed Preliminary Injunction, § A(b).) This language is
 12 problematic for many reasons. First, it provides notice to DEFENDANTS of which
 13 items would fall under the scope of the preliminary injunction. DEFENDANTS
 14 cannot calculate the potential harm caused by such an injunction because there is no
 15 way to know which bottles would be subject to the injunction.

16 This language is also problematic because a preliminary injunction is only
 17 warranted where Plaintiff has shown that it is **likely to succeed** on the merits,
 18 (2) that it is **likely to suffer irreparable harm** in the absence of preliminary relief,
 19 (3) that the balance of equities tips in its favor, and (4) that an injunction is in the
 20 public interest. By referencing these additional, unidentified items,
 21 DEFENDANTS cannot challenge any of the elements PLAINTIFF is required to
 22 establish before a preliminary injunction may be entered. If PLAINTIFF wants to
 23 expand the scope of its injunction to include additional items, it must identify those
 24 items so a proper preliminary injunction analysis can be performed.

25 As such, PLAINTIFF's proposed preliminary injunction is unacceptable and
 26 must be narrowly tailored to the allegedly infringing items PLAINTIFF has
 27 specifically identified.

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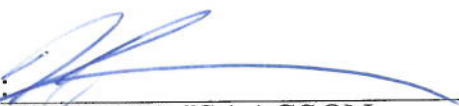
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1 **IV. CONCLUSION**

2 Because there are serious and substantial questions concerning the D'224
3 Patent's validity and obviousness, and in the absence of irreparable harm or public
4 interest favoring a preliminary injunction, the Court should deny PLAINTIFF's
5 Motion for Preliminary Injunction in its entirety. Alternatively, the Court should
6 narrow the proposed preliminary injunction to cover only those items identified and
7 analyzed by PLAINTIFF to avoid undue hardship and a non-meritorious
8 preliminary injunction.

9 Dated: February 24, 2014

TINGLEY LAW GROUP, PC

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11 By: 
12 KEVIN W. ISAACSON
13 Attorneys for Said Defendants
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